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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/029,408	10/01/1998	ANDREAS GERHARD BAAR	GEY-1020	6021

26418 7590 12/03/2002

REED SMITH, LLP
ATTN: PATENT RECORDS DEPARTMENT
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EXAMINER

NOLAN, SANDRA M

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/03/2002

26

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-26

Office Action Summary

Application No.

09/029,408

Applicant(s)

BAAR ET AL.

Examiner

Sandra M. Nolan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60-64 and 71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-64 and 71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Withdrawal of Allowance

1. The allowance of claims 60-64 and 71 is hereby withdrawn and prosecution is reopened in order to apply the new grounds of rejection set out herein.

Issue Fee Unpaid

2. The issue fee has not been paid for this application.

Summary of Claims

3. The pending claims can be summarized as follows:

Claim 60 reads on a process for making a substantially completely biodegradable molded body that is useful for packaging, which process comprises:

- a. mixing water and starch with a biodegradable fiber (bundle) with fiber lengths of 0.24 to 4.32 mm;
- b. placing the mix into a mold;
- c. heating the mix to form a cohesive mass;
- d. applying a biodegradable, hydrophobic, softener-free, liquid impermeable boundary layer to the mass of step c.

Claim 61 depends on claim 60 and calls for the use of a filler in step a.

Claim 62 depends on claim 61 and recites a Markush group of fillers, which group includes "talcum".

Claim 63 depends on claim 60 and states that the layer applied in step d may be a polyester film.

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Claim 64 depends on claim 60 and requires that the layer applied in step d may be made of cellulose acetate.

Claim 71 depends on claim 60 and calls for the use of fibers having lengths of 0.24 to 4.32 mm.

Note: The examiner's interpretation of the phrase "substantially completely biodegradable" is given below in the 35 USC 103 rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 60-64 and 71 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The phrase "substantially completely biodegradable" is deemed to be new matter because the examiner is unable to find support for it in the application as originally filed.

Please state the passage that supports this phrase or delete it from the claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 60-64 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haas et al (US 5,576,049) in view of Tiefenbacher et al (US 5,376,320).

Haas teaches the production of rotable starch based shaped articles (title, abstract), such as containers (col. 1, lines 5-6) using steps that are similar to steps a through d. That is, at col. 1, line 47+, it discussed:

-making up a composition containing water (col. 1, line 53), starch (col. 1, line 54), fiber (col. 2, lines 13-15) and talc (col. 2, line 17-18);

-putting it into a mold, and baking it (col. 2, lines 43-46).

Haas refers specifically to Tiefenbacher (US 5,376,320) at col. 1, lines 44-46.

The examiner infers from the title and abstract that the bodies made in the molding step are shaped and cohesive.

The examiner deems "talcum" to be the same filler as talc.

"Rotable" is deemed to mean biodegradable.

The phrase "substantially completely biodegradable" is deemed to encompass articles that are both biodegradable and non-biodegradable.

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Haas fails to teach the fiber lengths or the polyester films recited in applicants' claims.

Tiefenbacher teaches the use of talc (col. 9, line 34) and fiber lengths of 0.03 to 1.5 mm (col. 9, lines 11+) in shaped articles made from water/starch/filler/fiber mixes (col. 6, lines 34-49) via molding and baking steps (col. 14, lines 20-43). The bonding of its shaped bodies to sheets of polyethylene terephthalate is taught at col. 16, lines 33-34. Polyethylene terephthalate is a well known polyester.

The references are analogous because they both deal with the production of shaped articles from water/starch/fiber/filler mixes via molding and heating steps.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ fibers having the lengths taught by Tiefenbacher and/or the polyester films of Tiefenbacher when carrying out the process of Haas in order to make film-coated articles useful as rotable containers.

The motivation to employ the fibers and polyester films of Tiefenbacher is found at col. 1, lines 44-46, where Haas refers specifically to Tiefenbacher.

It is deemed desirable to make containers of rotable compositions via the process steps suggested by the combination of Haas and Tiefenbacher in order to make the containers more environmentally friendly.

Articles made using the processes suggested by the combined Haas and Tiefenbacher references are deemed to be both biodegradable and non-biodegradable because therein of both biodegradable and non-biodegradable ingredients.

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Conclusion

Any inquiry concerning this communication should be directed to the Examiner, Sandra M. Nolan, whose telephone number is 703/308-9545. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 703/308-4251. The general fax number for the art unit is 703/305-5436. The fax number for after final communications is 703/872-9310. The receptionist answers 703/308-0661.



S. M. Nolan
Patent Examiner
Technology Center 1700

SMN/smn
09029408(26)
November 29, 2002



HAROLD PYON
SUPERVISORY PATENT EXAMINER

1772

11/29/02